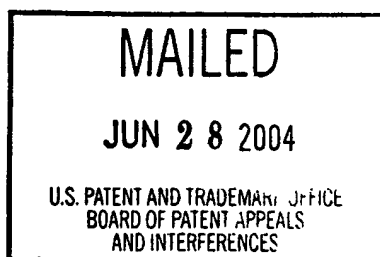


The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex Parte BOBBY HU

Appeal No. 2004-0912
Application No. 09/942,061

ON BRIEF

Before, WARREN, KRATZ and JEFFREY T. SMITH, *Administrative Patent Judges*.
JEFFREY T. SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicant appeals the decision of the Primary Examiner finally rejecting claims 21 to 25, 40, 41 and 57 to 59 all of the claims pending in the application.¹ We have jurisdiction under 35 U.S.C. § 134.²

¹ Appellants have canceled claims 42 to 56 in the after final communications filed March 13, 2003. The Examiner has entered this amendment. (Answer, p. 2).

² We have considered Appellant's position as presented in the Appeal Brief, filed March 13, 2003.

BACKGROUND

Appellant's invention is directed to a reversible ratchet type wrench. The scope of Appellant's invention can be ascertained from claim 21 which is reproduced below:

21. A reversible ratchet-type wrench comprising:

a handle;

a head extended from the handle;

a drive member rotatably mounted in the head, with the drive member including a plurality of teeth formed on an outer periphery thereof;

a pawl including a first side with a plurality of ratchet teeth for releasably engaging with the teeth of the drive member, with the pawl further including a second side with a recess;

a rotatable switch member including a turn-piece for manual operation and an actuating plate extended from the turn-piece, the switch member being switchable between two positions for changing ratcheting direction of the drive member, with the actuating plate of the switch member including a first receptacle that faces the recess of the pawl and that has a first end wall;

an elastic element; and

a peg, with the peg having a first end movably received in the recess of the pawl and a second end, with the second end of the peg being received in the first receptacle and including a second receptacle with a second end wall, with the elastic element located in the first and second receptacles between the first end wall and the second end wall, with the peg and the elastic member being rotatable with the actuating plate and biasing the ratchet teeth of the pawl to engage with the teeth of the drive member.

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The Examiner cited the following references to reject the claims:

Tuttle	1,426,127	Aug. 15, 1922
Kress	1,957,462	May 08, 1934
Kilness	3,265,171	Aug. 09, 1966
Fosella	5,076,121	Dec. 31, 1991
Arnold et al. (Arnold)	5,178,047	Jan. 12, 1993
Chow	5,533,427	Jul. 09, 1996
McCann	5,957,009	Sep. 28, 1999
Chen	6,164,167	Dec. 26, 2000
Hu	6,282,991	Sep. 04, 2001 (filed Apr. 03, 2000)
Hu	6,282,992	Sep. 04, 2001 (filed Apr. 03, 2000)
Hu	6,453,779	Sep. 24, 2002 (filed Mar. 21, 2001)
Hu	6,457,389	Oct. 01, 2002 (filed Aug. 06, 2001)
Hu	US 2002/0112573 (09/854,795)	Aug. 22, 2002 (filed May 14, 2001)
Hu	US 2002/0166416 (09/888,810)	Nov. 14, 2002 (filed Jun. 25, 2001)

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THE REJECTIONS³

The Examiner rejected entered the following ground of rejections:

Claims 21, 23, 41 and 57 to 59 are rejected under 35 U.S.C. § 103(a) over the combination of Kilness and Tuttle. (Answer, pp. 3-4).

Claims 22, 25 and 40, are rejected under 35 U.S.C. § 103(a) over the combination of Kilness, Tuttle and Chow. (Answer, pp. 4-5).

Claim 24 is rejected under 35 U.S.C. § 103(a) over the combination of Kilness, Tuttle and Arnold. (Answer, p. 5).

Claims 21 to 25, 40, 41 and 57 to 59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 4, 27, 34-37 of U.S. Patent No. 6,282,992. (Answer, pp. 5-6).

Claims 21 to 25, 40, 41 and 57 to 59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 38 of U.S. Patent No. 6,282,991 in view of Kress. (Answer, p. 6).

³ The Examiner has identified the rejection of claims 21-25 and 40-59 in several of the rejections in the Answer. However, claims 42-56 have been canceled in an after final amendment that the Examiner has entered. (Answer, p. 2). In these cases, the rejection will apply to all of the pending claims that remain, i.e., claims 21 to 25, 40, 41 and 57 to 59.

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Claims 21 to 25, 40, 41 and 57 to 59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 18 of copending application no. 09/814,430, now U.S. patent 6,453,779, in view of McCann. (Answer, pp. 6-7).

Claims 21 to 25, 40, 41 and 57 to 59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 20 of copending application no. 09/923,120, now U.S. patent 6,457,389, in view of McCann and Chen. (Answer, p. 7).

Claims 21 to 25, 40, 41 and 57 to 59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 60 of copending application no. 09/854,795 in view of Fosella, Kress, McCann and Chen. (Answer, p. 8).

Claims 21 to 25, 40, 41 and 57 to 59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 20 of copending application no. 09/888,810 in view of McCann and Chen. (Answer, p. 8).

OPINION

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the Examiner and Appellant in support of their respective positions. We will affirm the rejection of claims 21 to 25, 40, 41 and 57 to 59 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 4, 27, 34-37 of U.S. Patent No. 6,282,992. However, we reverse the remaining rejections. Our reasons for this determination follow.

Rather than reiterate the respective positions advanced by the Examiner and Appellants, we refer to the Examiner's Answer and to Appellant's Brief for a complete exposition thereof.

Rejections under § 103

All of the Examiner's § 103 rejections rely on, either totally or in-part, Kilness and Tuttle. Therefore, we will limit our discussion to Kilness and Tuttle and claim 21 which is the sole independent claim.

According to the Examiner, Kilness describes all of the limitations of claim 21 except for the location of the elastic member in the first receptacle. (Answer, pp. 3-4). The Examiner further asserts "[d]ifferent embodiments of actuating member, in which

the elastic member is located in a peg's receptacle and a second receptacle having an end wall against which the elastic member is biasing against, is old and known in the art as illustrated by Tuttle." (Answer, p. 4). However, this is not the structure recited in claim 21.

The subject matter of claim 21 specifies that the peg has a first end movably received in the recess of the pawl and a second end. The second end of the peg is received in the first receptacle, of the actuating plate of the switch member. The first receptacle contains a first end wall and faces the recess of the pawl. The first receptacle also includes a second receptacle with a second wall. The elastic element is located in the first and second receptacles between the first end wall and the second end wall. The peg and the elastic member is rotatable with the actuating plate and biases the ratchet teeth of the pawl to engage with the teeth of the drive member.

Tuttle does not disclose a first receptacle that contains a second receptacle with a second wall as required by claim 21. The Examiner has failed to identify what portion of the receptacle (23) of Tuttle would function as a second wall to form the second receptacle required by claim 21. Thus, if the teachings of Tuttle were combined with the teachings of Kilness as suggested by the Examiner the result would

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not have been the claimed structure. Unless the Kilness and Tuttle disclosures would have suggested to one of ordinary skill in the art at the time the invention was made that the first receptacle contained a second receptacle, the subject matter of claim 21 is not unpatentable under 35 U.S.C. §103 on this record. *In re Bond*, 910 F.2d 831, 835, 15 USPQ2d 1566, 1569 (Fed. Cir. 1990).

For the above reasons, the rejection of claims 21, 23, 41 and 57 to 59 under 35 U.S.C. § 103(a) over the combination of Kilness and Tuttle; claims 22, 25 and 40 under 35 U.S.C. § 103(a) over the combination of Kilness, Tuttle and Chow; and claim 24 under 35 U.S.C. § 103(a) over the combination of Kilness, Tuttle and Arnold are reversed.

Obviousness-type Double Patenting

Claims 21 to 25, 40, 41 and 57 to 59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 4, 27, 34-37 of U.S. Patent No. 6,282,992. We affirm.

The Appellant does not dispute that the appealed claims are patentably indistinct from the claims 3, 4, 27, 34-37 of U.S. Patent No. 6,282,992. Rather, the Appellant's

position is that “Applicant agrees to file a terminal disclaimer in this application relating to U.S. Patent No. 6,282,992.” (Brief, p. 11). However, Appellant does not cite any legal authority for the proposition that the mere offer to file a terminal disclaimer overcomes a rejection based on the judicially created doctrine of obviousness-type double patenting. We therefore uphold with the Examiner’s rejection.

We now turn to the remaining double patenting rejections. As identified above, the Examiner also rejected claims 21 to 25, 40, 41 and 57 to 59 under the judicially-created doctrine of obviousness-type double patenting over other patents and copending applications.⁴ An obviousness-type double patenting analysis entails two steps: (1) determine the differences between the subject matter of the pending and patented claims and (2) determine whether the differences render the claims patentably distinct. *Eli Lilly and Co. v. Barr Labs. Inc.*, 251 F.3d 955, 968, 58 USPQ2d 1869, 1878 (Fed. Cir. 2001). Claims are not patentably distinct, and thus properly rejected for obviousness-type double patenting, when the subject matter of those claims is obvious over, or anticipated by, the subject matter of the patented claim. *Id.*

⁴ Our discussion also applies to the provisional obviousness-type double patenting rejections that have been applied in the present record.

In the present case, the Examiner has failed to address differences between the claimed subject matter of the pending and patented claims with the claimed subject matter of the present application. For example, in the rejection over the U.S. Patent 6,453,779 the Examiner does not provide a discussion of the specific claims with the conflicting subject matter. The Examiner refers to the disclosure of the patent and the figures as the basis to support the rejection. (Answer, pp. 5-6). The Examiner's discussion of these double patenting rejections lacks the necessary findings of fact to establish that the claims are not patentably distinct. Therefore, the Examiner failed to establish a *prima facie* case of obviousness-type double patenting. It must be remembered that the initial burden of establishing a *prima facie* case of unpatentability rests upon the Examiner. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

For these reasons, the rejection of claims 21 to 25, 40, 41 and 57 to 59 under the judicially created doctrine of obviousness-type double patenting over claims 1 to 38 of U.S. Patent No. 6,282,991 in view of Kress; claims 21 to 25, 40, 41 and 57 to 59 under the judicially created doctrine of obviousness-type double patenting over claims 1 to

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18 of copending application no. 09/814,430, now U.S. patent 6,453,779, in view of McCann; claims 21 to 25, 40, 41 and 57 to 59 under the judicially created doctrine of obviousness-type double patenting over claims 1 to 20 of copending application no. 09/923,120, now U.S. patent 6,457,389, in view of McCann and Chen; the provisional rejection of claims 21 to 25, 40, 41 and 57 to 59 under the judicially created doctrine of obviousness-type double patenting over claims 1 to 60 of copending application no. 09/854,795 in view of Fosella, Kress, McCann and Chen; the provisional rejection of claims 21 to 25, 40, 41 and 57 to 59 under the judicially created doctrine of obviousness-type double patenting over claims 1 to 20 of copending application no. 09/888,810 in view of McCann and Chen are reversed.

OTHER ISSUES

We leave these issues to be further explored by the Examiner prior to disposition of the application. The Examiner should evaluate the claimed subject matter in view of the teachings of Kress, U.S. Patent 1,957,462, that teaches a known biasing structure. Kress appears to describe a peg (41) has a first end movably received a recess. The second end of the peg is received in a first receptacle (43) that

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contains a first and a second end wall.⁵ The elastic element (42) is located in the first and second receptacles between the first end wall and the second end wall.

CONCLUSION

For the foregoing reasons, based on the totality of the record, we affirm the rejection of claims 21 to 25, 40, 41 and 57 to 59 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 4, 27, 34-37 of U.S. Patent No. 6,282,992. We reverse the remaining rejections.


⁵ Note the “v” shaped wall of receptacle (43) appears to function as one wall for the peg and a separate wall for the spring.

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Time for taking action

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


CHARLES E. WARREN)

CHARLES F. WARREN
Administrative Patent Judge

Pete F. Kent

PETER F. KRATZ
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

Mary E. Jones

JEFFREY T. SMITH
Administrative Patent Judge

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